

12-12-07

AT

TW

Express Mail Label No. EV942369241US

Date of Deposit: December 10, 2007

Attorney Docket No.: 27996-051



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Jerry Freestone, *et al.* Examiner: Michael Young Won
Serial No.: 09/668,875 Group Art Unit: 2155
Filed: September 25, 2000 Confirmation No.: 3055
Attorney Docket No.: 27996-051

Title: **METHOD FOR ANNOUNCING E-MAIL AND CONVERTING E-MAIL TO VOICE**

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER

Transmitted herewith for filing in the above-identified patent application are the following documents:

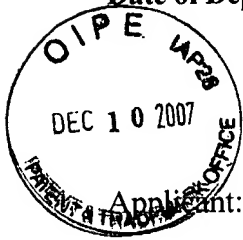
1. Appellants' Reply Brief pursuant to 37 C.F.R. §41.41 (5 pages) (in triplicate, 15 pages total); and
2. Return Postcard.

The Commissioner is hereby authorized to charge any fees that may be due, or to credit any overpayment, to Deposit Account No. **50-0311**, Ref. No.: **27996-051**. A duplicate copy of this Transmittal Letter is enclosed.

Respectfully submitted,

Dated: December 10, 2007

Boris A. Matvenko, Reg. No. 48,165
Attorney/Agent for Applicants
MINTZ LEVIN COHN FERRIS, *et al.*
666 Third Avenue - 24th Floor
New York, New York 10017
Telephone: (212) 935-3000
Telefax: (212) 983-3115



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Jerry Freestone, *et al.* Examiner: Michael Young Won
Serial No.: 09/668,875 Group Art Unit: 2155
Filed: September 25, 2000 Confirmation No.: 3055
Attorney Docket No.: 27996-051

Title: **METHOD FOR ANNOUNCING E-MAIL AND CONVERTING E-MAIL
TO VOICE**

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

Sir:

I. INTRODUCTION

Appellants submit this Reply Brief in response to the October 9, 2007 Examiner's Answer. This Reply Brief is due on or before December 10, 2007 (December 9, 2007 being a Sunday). Appellants have previously paid all the corresponding fees relating to this appeal. No fees are believed due in connection with this submission. However, the Commissioner is authorized to charge any necessary fees that may be due or credit any overpayment to Appellants' Deposit Account No. 50-0311, Reference No. 27996-051.

This Reply Brief addresses the following points raised by the Examiner in the October 9, 2007 Examiner's Answer (See, Examiner's Answer, page 11):

(i) Whether "program identifier" or "program segment identification numbers" disclosed in U.S. Patent No. 5,732,216 to Logan et al. (hereinafter, "Logan") indicates the course of action

or sequence of events to be played back as asserted by the Examiner in the October 9, 2007 Examiner's Answer.

(ii) Whether it is inherent based on the teachings in Logan that if a sound file is attached to an email the associate identifier would also be attached, as asserted by the Examiner in the October 9, 2007 Examiner's Answer.

II. ARGUMENT

Appellants reiterate and incorporate herein by reference all of their arguments previously presented in the Appellants' Appeal Brief, filed April 20, 2007, and Appellants Amended Brief, filed July 5, 2007 (hereinafter, "Appellants Appeal Brief").

(i) Contrary to the Examiner's assertion in the October 9, 2007 Examiner's Answer, Logan fails to disclose, teach or suggest, *inter alia*, an electronic message configured to be communicated between a sender's device and a recipient's device, the electronic message having a predetermined identifier, associated with the sound file, that both distinguishes said sound file from other files attached to the message and indicates a course of action to be taken by the recipient's device with the sound file, as recited in claim 1.

As previously stated in Appellants' Appeal Brief, Logan discloses an audio message exchange system in which multiple exchanges of information are made between a host server and a player device. (Logan, FIG. 1). Logan's host server transmits a download compilation file upon receiving a request from a player. (Logan, Col. 5, lines 46-48). Logan's compilation file takes the form of one or more subscriber and session specific files that contain identification of separately stored sharable files. (Logan, Col. 5, lines 63-66). Logan stores a session schedule file that contains program identifiers of the program segments to be played during a session. (Logan, Col. 6, lines 2-5). The recommended order and identification of the program files making up an

individual session are stored in the session schedule file. (Logan, Col. 5, line 67 to Col. 6, line 2). Logan's player downloads the session file and then issues download requests for program segment files. (Logan, Col. 6, lines 5-8). Logan includes a schedule file that consists of a sequence of program segment identification numbers which are used to compile a sequence file. The sequence file contains more detailed information from the selections file that identifies the individual program segments to be fetched from mass storage and played to the user. (Logan, Col. 11, lines 4-15).

In this passage, Logan does not address "electronic message(s)", which is contrary to the recitation of claim 1. Further, Logan does not identify any kind of course of action to be taken by the recipient's device. Logan's identifiers link each program segment in the downloaded compilation. Logan's identifiers **do not distinguish** each segment from the other segments in the compilation and, instead, are used by a player to issue download requests for files that are not already in the user's storage. (emphasis supplied). This is different than present invention's predetermined identifier, associated with the sound file, that distinguishes the sound file from other files attached to the message, as recited in claim 1. Additionally, Logan's selections file, and **not the identifiers**, "contains more information about the sequence of events which occur during playback." (Logan, Col. 11, lines 8-10). (emphasis supplied). However, none of Logan's identifiers indicate a course of action to be taken by the recipient's device with the sound file, as recited in claim 1. In contrast, Logan's identifier merely serve to **identify program segments** within a program, rather than provide a course of action to be taken by the recipient's device. (emphasis supplied).

As such, Logan clearly fails to disclose, teach or suggest the above elements of claim 1. Thus, for the reasons stated above and in the Appellants' Appeal Brief, the combination of

Logan and U.S. Patent No. 6,085,231 to Agraharam et al. (hereinafter, "Agraharam") fail to render claims 1-45 obvious.

(ii) In the October 9, 2007 Examiner's Answer, Examiner asserts that "it is inherent, according to Logan's teachings ..., that if sound file were attached to an email the associate identifier would also be attached." Appellants respectfully disagree.

According to MPEP 2112:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) ... "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)...

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)...

As Appellants noted above and in the Appellants' Appeal Brief, Logan fails to disclose, teach or suggest, the electronic message having a predetermined identifier, associated with the sound file, that both distinguishes said sound file from other files attached to the message and indicates a course of action to be taken by the recipient's device with the sound file, as recited in claim 1. As such, based on Logan's teachings, it would not be inherent to attach present invention's identifier to the electronic message. In support of Examiner's inherency assertion, Examiner fails to provide any other extrinsic evidence and/or technical reasoning (besides

Logan), which is contrary to the requirements of MPEP 2112. Thus, Examiner's statement is not inherent based on Logan. As such, it would not be recognized by a person of ordinary skill in the art that a "the electronic message having a predetermined identifier, associated with the sound file, that both distinguishes said sound file from other files attached to the message and indicates a course of action to be taken by the recipient's device with the sound file" is an inherent property of Logan's audio message exchange system. Thus, the Examiner's assertion regarding the "associate identifier" is improper and cannot serve as a basis for rejection of Appellants' claims.

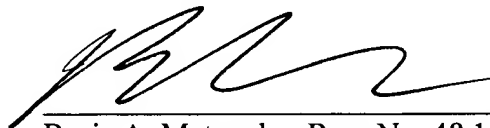
Hence, the combination of Logan and Agrapharam does not support a prima facie case of obviousness as suggested by the Examiner and the rejection of claims 1-45 is respectfully traversed.

III. CONCLUSION

For the reasons presented in this Reply Brief and in the Appellants' Appeal Brief, Appellants respectfully submit that the claimed inventions are novel and non-obvious over the cited prior art. Accordingly, Appellants request the Board reverse the Examiner's rejections.

Respectfully submitted,

Dated: December 10, 2007



Boris A. Matvenko, Reg. No. 48,165
Attorney/Agent for Applicants
MINTZ LEVIN COHN FERRIS, *et al.*
666 Third Avenue - 24th Floor
New York, New York 10017
Telephone: (212) 935-3000
Telefax: (212) 983-3115